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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,672	08/21/2000	Gerd Cornils	3633-489	9683
22850	7590	04/01/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EASHOO, MARK	
			ART UNIT	PAPER NUMBER
			1732	
DATE MAILED: 04/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/529,672

### Applicant(s)

CORNILS ET AL.

### Examiner

Mark Eashoo, Ph.D.

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,20-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,20-31 and 33-39 is/are rejected.
- 7) ☒ Claim(s) 5,32 and 40-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6, 7 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by over Walter (DE 43 26 179 AI). *For convenience, the column and line references for Walter refer to the location in the English translation.*

Regarding claims 1-4, and 33-34: Walter teaches the basic claimed process for working a portion of a profiled strand on a window, comprising: a superimposed/overlapped mass of two extruded segments on a window edge(2:24-35 and Fig. 2); shaping the superimposed/overlapped mass with a pressing tool in a pane corner, after extrusion thereof, wherein excess material is forced out of the tool for removal (2:24-35 and 4:36-38). Walter teaches an automated handling unit used to apply two spaced bead having a defined cross-section (4:15-30 and Fig. 2). Since the beads overlap and extend along two sides of the window, it is inherent that the extrusion die/unit is moved away from an extrusion path along a first edge and rotated to the direction and/or path along a second edge.

Regarding claim 7: It is inherent that the pressing tool is in a first position (ie. molds apart) to a second position proximate the superposed/overlapped material (ie. molds together) and that it must be at least partially aligned in some manner to function properly.

Regarding claim 34: Since the beads overlap and extend along two sides of the window, it is inherent that the extrusion die/unit is moved away from an extrusion path along a first edge and rotated to the direction and/or path along a second edge.

Claims 20-25 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by over Walter (DE 43 26 179 AI). *For convenience, the column and line references for Walter refer to the location in the English translation.*

Regarding claims 20-22, 25, and 29: Walter teaches the basic claimed process for working a portion of a profiled strand on a window, comprising: a superimposed/overlapped mass of two extruded segments on a window edge(2:24-35 and Fig. 2); shaping the superimposed/overlapped mass with a pressing tool in a pane corner, after extrusion thereof, wherein excess material is forced out of the tool for removal (2:24-35 and 4:36-38).

Regarding claims 23 and 24: Since Walter teaches that excess material is removed and that some stays in the mold during pressing, being formed into the desired shape, it is inherent that first and second portions are formed with the second portion or excess being removed (4:4-38).

Regarding claims 27-28 and 30-31: Walter also teaches the pressing tool has upper and lower portion with a space for excess extruded material to flow between the upper and lower portions (Fig. 2). It is inherent that the pressing tool is in a first position (ie.

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molds apart) to a second position proximate the superposed/overlapped material (ie. molds together) and that it must be at least partially aligned in some manner to function properly.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 35-37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter (DE 43 26 179 AI) in view of Kunert et al. (US Pat. 5,057,265). *For convenience, the column and line references for Walter refer to the location in the English translation.*

Regarding claim 35: Walter teaches the basic claimed process for working a portion of a profiled strand, comprising: a superimposed/overlapped mass of two extruded segments (2:24-35); shaping the superimposed/overlapped mass with a pressing tool, after extrusion thereof, wherein excess material is forced out of the tool for removal (2:24-35 and 4:36-38).

Walter is silent about moving a window with extruded profile beads thereon to a location where the pressing tool is located. Since it is common in the art that the extruded profile beads are applied by a moving extrusion head, it appears that the window is not transferred or repositioned after extrusion.

Walter does not specifically teach that the overlap portions are shapeless. Nonetheless, Kunert et al. teaches that when an extrusion head is moved away from the window to terminate the application of the bead, a shapeless mass results ( Figs. 2 and 3). Since the beads of Walter overlap, it is inherent that the upper bead would lose it's profile shape as taught by Kunert et al. If not inherent, then at the time of invention a person of ordinary skill in the art would have found it obvious to have formed a shapeless mass, as taught by Kunert et al., in the process of Walter, and would have been motivated to do so in order not to destroy the first bead by applying the second.

Regarding claims 36, 37, 39: Walter teaches an automated handling unit used to apply two spaced bead having a defined cross-section (4:15-30 and Fig. 2). Since the beads overlap and extend along two sides of the window, it is inherent that the extrusion die/unit is moved away from an extrusion path along a first edge and rotated to the direction and/or path along a second edge.

Regarding claim 38: Walter teaches a working portion of first and second beads which extend beyond the periphery of the window (Fig. 2).

Claims 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter (DE 43 26 179 AI). *For convenience, the column and line references for Walter refer to the location in the English translation.*

Walter teaches the basic claimed process for working a portion of a profiled strand on a window, comprising: a superimposed/overlapped mass of two extruded segments on a window edge(2:24-35 and Fig. 2); shaping the

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superimposed/overlapped mass with a pressing tool in a pane corner, after extrusion thereof, wherein excess material is forced out of the tool for removal (2:24-35 and 4:36-38).

Walter does not teach using a heated pressing tool. However, heated compression molds are well known in the molding art. At the time of invention a person having ordinary skill in the art would have found it obvious to have used a heated pressing tool or compression mold, as commonly practiced in the art, in the process of Walter, for the benefit of aiding the material to flow along the surface of the mold thereby forming a more uniform surface.

Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter (DE 43 26 179 A1). *For convenience, the column and line references for Walter refer to the location in the English translation.*

Walter teaches the basic claimed process for working a portion of a profiled strand on a window, comprising: a superimposed/overlapped mass of two extruded segments on a window edge(2:24-35 and Fig. 2); shaping the superimposed/overlapped mass with a pressing tool in a pane corner, after extrusion thereof, wherein excess material is forced out of the tool for removal (2:24-35 and 4:36-38). Walter teaches an automated handling unit used to apply two spaced bead having a defined cross-section (4:15-30 and Fig. 2). Since the beads overlap and extend along two sides of the window, it is inherent that the extrusion die/unit is moved away from an extrusion path along a first edge and rotated to the direction and/or path along a second edge.

Walter is silent about moving a window with extruded profile beads thereon to a location where the pressing tool is located. Since it is common in the art that the extruded profile beads are applied by a moving extrusion head, it appears that the window is not transferred or repositioned after extrusion or would be an obvious variation thereof since moving tools or work-piece to a working location is well known in the molding art.

### ***Double Patenting***

Claim 42 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 32.

Claim 43 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 40.

Claim 44 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 41.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

To overcome this double patenting rejection, it is suggested that applicant cancel claims 32, 40, and 41.

***Allowable Subject Matter***

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claim is allowable because of the reasons set forth in applicant's remarks 02-MAR-2004.

Claims 32, 40, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims as set forth in the prior Office action.

***Response to Arguments***

Applicant's arguments filed 02-MAR-2004 have been fully considered but they are not persuasive.

1.) Applicant's argument that the extrudate of the applied reference is not "shapeless" is not persuasive because: Walter teaches that the two extruded strands that initially overlap and are later formed into a 'desired dimension' by a press-molding tool. The extruded materials are semi-fluid and not a "gas or vapor", it is inherent that they are not truly 'shapeless' but have some type of shape. The extruded bead/strands would inherently be in a hot, semi-fluid state upon extrusion and the fact that the overlap area is not initially in its final shape. A person having ordinary skill in the art would understand that the overlap is essentially "shapeless", as understood in the art of molding, because the overlap is not in final form.

2.) Applicant's argument regarding that the international search report states that the applied reference is an "A" reference is irrelevant because the requirements for international and U.S. patentability are subject to different standards. Accordingly, the references are viewed or interpreted differently.

3.) Applicant does not argue the rejection(s) of claim 20 and those dependent thereon as no argument is clearly presented which is directed to these claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (703) 308-3606. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Mark Eashoo, Ph.D.  
Primary Examiner  
Art Unit 1732

29/Mar/04

me  
29-Mar-04